

REMARKS**Rejections under 35 U.S.C. §101 and 112, 1st paragraph**

The Examiner maintains the rejection of the claims under 35 U.S.C. §§101 and §112, 1st paragraph for an asserted lack of utility. The Examiner notes that the invention must have a credible, specific and substantial utility. The Examiner notes that the asserted utility for the instant invention is credible and specific, but not substantial. With regard to the asserted lack of substantiality of the utility the Examiner states, “An assertion that the claimed polypeptides can be used to bind the antibodies is not substantial, since it is only for further research regarding the function of the claimed polypeptides in the cell with respect to G-CSF function.” In the Advisory Action of October 28, 2005, the Examiner further states that the asserted utility for the invention is not substantial because “further research would be required to reasonably confirm the asserted utility.”

Applicants again traverse this rejection and withdrawal there of is respectfully requested. The Examiner offers the arbitrary conclusion that the real world, i.e. substantial utility, stated for the invention is not adequate because further research would be required. However, the Examiner offers no evidence or analysis for this arbitrary conclusion. Why does the Examiner doubt the proffered utility and believe that more research be required? An arbitrary conclusion/rejection without evidence in support thereof is an improper foundation for maintaining the rejection.

In addition, attached hereto as evidence of the utility of the invention, is U.S. 2004/0052789. The Examples of the present specification describe the identification of the MMR-CAM protein, which falls within the scope of the invention. The MMR-CAM protein of the instant specification is the same protein named as “MMRP19” in the Examples of US


2004/'789. Examples 6-14 of US 2004/'789, in particular Examples 7, 13, and 14, clearly demonstrate that the MMRP19/MMR-CAM protein is a transmembrane protein that is involved with G-CSF production. Specifically, Example 7, 13 and 14 of US 2004/'789 demonstrates the involvement of induction of G-CSF gene expression and production of G-CSF. These experiments demonstrate that the asserted utility of the invention is substantial. As discussed by the Court of Appeals for the Federal Circuit, *in vitro* testing is sufficient to support the asserted utility of an invention. *In re Fisher*, 76 USPQ2d, 1125, 1234 (Fed. Cir. 2005). As such, withdrawal of the rejection and allowance of the claims are respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

In view of the above amendment, applicant believes the pending application is in condition for allowance. If the Examiner has any questions regarding the present application, she is requested to please contact the undersigned.

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Respectfully submitted,

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Attachment: US 2004/0052789